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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/590,951	11/08/2006	Franz jun. Neuhofer	NEUHOFFER, JR.-16 PCT	3739
25889	7590	03/31/2009		
COLLARD & ROE, P.C. 1077 NORTHERN BOULEVARD ROSLYN, NY 11576			EXAMINER TRIGGS, ANDREW J	
			ART UNIT 3635	PAPER NUMBER
			MAIL DATE 03/31/2009	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/590,951

Applicant(s)

NEUHOFFER, FRANZ JUN.

Examiner

Andrew J. Triggs

Art Unit

3635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 February 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2-4 and 7-9 is/are rejected.
- 7) ☒ Claim(s) 5-6 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

Allowable Subject Matter

1. Claims 5 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
2. The following is a statement of reasons for the indication of allowable subject matter: Stanchfield teaches in Figure 18, that the compensating strip has a peripheral projection but the projection is retained by the clamping web and not the underside of the covering flange. Furthermore, the peripheral projection of Stanchfield is square which would not allow the compensating strip to pivot.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074.

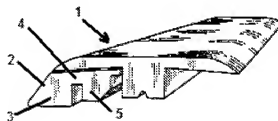
Regarding claim 9, Stanchfield teaches a covering device for joints in panels such as floor panels (Abstract). Stanchfield teaches that the cover can be made of plastic based products, such as PVC (Column 4, Lines 50-51). These types of materials are commonly formed by extruding them through a machine to create the desired profile. Stanchfield teaches, in Figure 2, a clamping web (16) that protrudes

downward from the covering flange (12) and extends in a longitudinal direction along the cover. The clamping web (16) is used to secure the cover by inserting it into the clamp (26). Stanchfield also teaches a compensating strip (40) on the underside of the covering flange that engages the covering flange with a tongue and groove mechanism (18). Stanchfield also teaches, in Figure 2, that the floor covering (12) is flat over the floor (24 and 25) of which it covers. Stanchfield teaches, in Figure 2, that the tongue (18) is on the covering device and the groove (42) is on the compensating strip (40) as seen in Figure 3. Stanchfield discloses the claimed inventions except for the tongue and groove mechanisms are reversed. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to make the cover with the groove and the compensating strip with the lug, since it has been held that a mere reversal of the essential working parts of a device involves only routine skill in the art. *In re Einstein*, 8 USPQ 167. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

Regarding claims 7 and 8, the applicant should note, regarding the recitation of method claims that depend from product claims, that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

5. Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941.

Regarding claim 2, Stanchfield teaches a covering device with a compensating strip that has a tongue and groove connecting mechanism but does not teach the compensating strip has two legs. However, Neuhofer teaches in the annotated figure below, a covering device (1) with a compensating strip (2) that has a basic form of an angle and two legs (3 and 4). In combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. Furthermore, it can be seen that the compensating strip (2) makes an extension of the cover (1) extending downward. One of ordinary skill in the art at the time of the invention would have been motivated to have a compensating strip with two legs because the legs form a continuation of the covering device that creates a smooth even flowing cover over a gap between panels. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.



Regarding claim 3, Stanchfield teaches a compensating strip but does not teach a supporting leg connected to the leg that has the tongue and groove mechanism. However, Neuhofer teaches in the annotated figure above, that the compensating strip (2) has a supporting leg (5) projecting from leg (4). In

combination with Stanchfield, leg (4) would have the tongue and groove mechanism on it. One of ordinary skill in the art at the time of the invention would have been motivated to further include a supporting leg because a groove between the supporting leg and other leg can be used to secure the compensating strip securely. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

6. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stanchfield, US Patent # 6,860,074 in view of Neuhofer, US Design Patent # D542,941 in further view of Kemper, US Patent # 6,345,480.

Regarding claim 4, Stanchfield in view of Neuhofer teach a cover device that has a supporting leg on the compensating strip. It can be seen in Figure 1 of Neuhofer that there is a channel between the legs that is capable of accepting a fixture from the profile cover but Stanchfield only teaches one securing means (26) on the fixture. However, Kemper teaches the use of two securing means (6 and 12) on the fixture (3). One of ordinary skill in the art at the time of the invention would have been motivated to include two or more securing means on the floor mounting plate fixture in order to secure not only the covering device but also the compensating strip to the floor. Therefore, the invention as a whole would have been obvious to one of ordinary skill in the art at the time of the invention.

Response to Arguments

7. Applicant's arguments have been fully considered but they are not persuasive.

The Applicant's Attorney continues to argue against the case law found *In re Einstein* where it was decided that "a mere reversal of the essential working parts of a device only involves routine skill in the art". The Examiner traverses the Applicant's Attorney based on the reason that the decision comes from case law.

The Applicant's Attorney goes on to argue that the advantage of having the groove in the cover is also to allow the device to be placed directly on the floor without the use of the compensating strip. Stanchfield's current design would not allow this on the side that requires the compensating strip, but reversal of parts would allow this to happen. Furthermore, Figure 2 of Stanchfield shows that the other side of the strip allows placement of the cover directly on the floor since there is no tongue and groove joint on that side. In other words, the cover of Stanchfield has the same versatility of the Applicant's since it can be used with a compensating strip on one side and rest directly on the floor on the other.

The next argument is saying that neither Stanchfield nor any of the cited art teaches that the cover can be used on floor surfaces that have the same height as well as floor surfaces that are uneven. However, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

The next argument is again toward the case law of *In re Einstein* where Stanchfield and all the cited art teach away from placing a groove in the cover because the groove would weaken the cover and the fact that the Applicant's invention produces unexpected results. However, there is nothing structurally about the cover that would make it less susceptible to breaking because of the groove in it. The Applicant's Attorney has stated that nobody has put the groove in the cover because it would weaken it. However, that means that putting the groove in the cover has been considered before. Furthermore, the specification states in the description of the prior art that the previous covers could be placed against the floor without a compensating strip but the extra material of the tongue would need to be removed. That being said, reversing the tongue and groove is a design choice that was considered in the past but was not used due to the weakening of the cover. During its consideration it was recognized that it would be advantageous to have the cover flat so it could be placed on the floor without the tongue in the way. But in order to create a stronger cover, designers would not place the groove in the cover and if it were needed to rest flat on the floor, the tongue would be removed. Furthermore, the claims are claiming the combination of the cover and the compensation strip, not the cover and the floor without the compensation strip.

The next argument is toward the **method** claims 7 and 8 that depend from the independent product claim. From the rejection above, the Examiner has rejected these claims by pointing out the recitation of method claims that depend from

product claims, that even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.

The next argument is toward claim 3 as that the leg shown in the secondary reference is not a **supporting** leg. However, this argument is mere speculation of the reference because it does not show it supported on anything. However, if the leg of the reference was placed on a surface, it is certainly capable of providing support.

8. Applicant's arguments with respect to claim 5 have been fully considered and are persuasive. The 35 USC 103 rejection of claim 5 has been withdrawn.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew J. Triggs whose telephone number is 571-270-3657. The examiner can normally be reached on Monday through Thursday 7:00am - 5:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard E. Chilcot can be reached on 571-272-6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Richard E. Chilcot, Jr./
Supervisory Patent Examiner, Art Unit 3635

/Andrew J Triggs/
Examiner, Art Unit 3635